UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,973	12/30/2004	Hiroshi Ikeda	04889/LH	6936

1933 7590 02/07/2008 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708	**EXAMINER** DICKER, DENNIS T

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
02/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 December 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 December 2004* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *See Attached*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Specification

1.   Applicant is reminded of the proper language and format for an abstract of the

disclosure.

The abstract should be in narrative form and generally limited to a single

paragraph on a separate sheet within the range of 50 to 150 words. It is important that

the abstract not exceed 150 words in length since the space provided for the abstract

on the computer tape used by the printer is limited. The form and legal phraseology

often used in patent claims, such as "means" and "said," should be avoided. The

abstract should describe the disclosure sufficiently to assist readers in deciding whether

there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information

given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure

describes," etc.

2.   The abstract of the disclosure is objected to it is not generally limited to a single

paragraph. (See abstract). Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-3 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Yoshino (hereinafter "Yoshino '879" 7,259,879) in view of Ishida (hereinafter

"Ishida '868" 6,619,868).

With respect to **Claim 1**, Yoshino '879 teaches a print ordering sheet for group

members **(i.e., Fig. 14 , Image selection page for a group of members)**, which is

used via a shop when the group member places an order for prints of photographed

images **(i.e., Col. 3 Lines 1-7, A member of a group is able to place an order for

prints)** stored in an information recording medium shared by the group members **(i.e.,

Col. 4 Lines 35-40, photographed images may be stored on information recording

mediums)** , comprising; a display section **(i.e., 20c of fig. 1, Personal computer with

a monitor)** for displaying a visual list of total printed images of produced from the

photographed images **(i.e., col. 8 Lines 34-40,)**; a print order assigning section **(I.e., 6c

of Fig. 1, server)** attached for each printed image on the list **(i.e., col. 1 Lines 54-60,)**;

a control information displaying section **(i.e., Fig. 4, group table displaying control

information)** for displaying control information relevant to a group **(i.e., Fig. 4, group

table displays information relevant to a group)**; an identification writing section **(i.e.,

84 of Fig. 8, order processing section)** for writing identification information of the

group member **(i.e., 84 of Fig. 8, writing of identification information of a member

such as name)**.

Yoshino '879 does not explicitly teach a print ordering sheet comprising an address displaying section for displaying a contact address of the shop which receives the print order from the member.

However, the mentioned claimed limitations are well known in the art as evidenced by Ishida '868, In particular, Ishida '868 teaches the use of A print ordering sheet comprising an address displaying section **(i.e., Fig. 3, display section comprising an address of a print shop)** for displaying a contact address of the shop which receives the print order from the member **(i.e., Fig. 3, contact address of the print shop which receives the print order from the member).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the print ordering sheet of Wan '076 as taught by Ishida '868 since Ishida '868 suggested in Col. 2 lines 65-67 that such a modification would be to send order information efficiently.

With respect to **Claim 2**, Yoshino '879 teaches a print ordering sheet, wherein the identification writing section has a column for writing a name and a membership number of at least on of the group members **(I.e., 81 of Fig. 8, order processing section for entering name and member)**

With respect to **Claim 3**, Yoshino '879 teaches a print ordering sheet, wherein the control information **(I.e., Fig. 4, group table)** comprises a group identification for identifying the group **(I.e., Fig. 4, group table comprising a group ID for identifying the group)** and an image identification number for identifying the photographed images **(I.e., Fig. 4, photographed images contain identification numbers)** and wherein the

group identification number and the image identification number are correspondent

each other **(I.e., col. 10 lines 19-20, image identification numbers are generated**

corresponding to a specific group identification number) .

With respect to **Claim 5**, Yoshino '879 teaches a print ordering sheet, wherein

the print order assigning section **(i.e., 6 of Fig. 1, server)** has a column for producing

an information recording medium including electronic data of the image to be printed

(i.e., Col. 4 Lines 35-40, server produces electronic of data of the image to be

printed from the information recording medium).

With respect to **Claim 6**, Yoshino '879 does not explicitly teach a print ordering

sheet, wherein the facsimile number of the shop is displayed in the address displaying

section,

However, the mentioned claimed limitations are well known in the art as

evidenced by Ishida '868, In particular, Ishida '868 teaches the use of a print ordering

sheet wherein the facsimile number of the shop is displayed in the address displaying

section **(i.e., Fig. 3, input screen for displaying facsimile number of shop).**

In view of this, it would have been obvious to one having ordinary skill in the art

at the time of invention was made to modify the print ordering sheet of Wan '076 as

taught by Ishida '868 since Ishida '868 suggested in Col. 2 lines 65-67 that such a

modification would be to send order information efficiently.

With respect to **Claim 7**, Yoshino '879 does not explicitly teach a print ordering sheet, wherein the telephone number of the shop is displayed in the address displaying section.

However, the mentioned claimed limitations are well known in the art as evidenced by Ishida '868, In particular, Ishida '868 teaches the use of a print ordering sheet wherein the telephone number of the shop is displayed in the address displaying section **(i.e., Fig. 3, input screen for displaying telephone number of shop).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the print ordering sheet of Wan '076 as taught by Ishida '868 since Ishida '868 suggested in Col. 2 lines 65-67 that such a modification would be to send order information efficiently.

With respect to **Claim 8**, Yoshino '879 does not explicitly teach a print ordering sheet, wherein the email address of the shop is displayed in the address displaying section.

However, the mentioned claimed limitations are well known in the art as evidenced by Ishida '868, In particular, Ishida '868 teaches the use of a print ordering sheet wherein the email address of the shop is displayed in the address displaying section **(i.e., Fig. 3, input screen for displaying supplementary information such as email address of the shop)**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the print ordering sheet of Wan '076 as

taught by Ishida '868 since Ishida '868 suggested in Col. 2 lines 65-67 that such a modification would be to send order information efficiently.

With respect to **Claim 9**, Yoshino '879 teaches a print ordering sheet further comprises an expiration date displaying section for displaying an expiration date of the print order **(i.e., Fig. 21, expiration date displaying section for displaying an expiration date of the print order).**

With respect to **Claim 10**, Yoshino '879 does not explicitly teach a print ordering sheet further comprises an additional information displaying section for displaying additional information.

However, the mentioned claimed limitations are well known in the art as evidenced by Ishida '868, In particular, Ishida '868 teaches the use of a print ordering sheet further comprising an additional information displaying section for displaying additional information **(i.e., Fig. 3, input screen for displaying supplementary information such as additional information).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the print ordering sheet of Wan '076 as taught by Ishida '868 since Ishida '868 suggested in Col. 2 lines 65-67 that such a modification would be to send order information efficiently.

With respect to **Claim 11**, Yoshino '879 does not explicitly teach a print ordering sheet wherein the additional information is an advertisement of the shop or news of the district.

However, the mentioned claimed limitations are well known in the art as evidenced by Ishida '868, In particular, Ishida '868 teaches the use of a print ordering sheet wherein the additional information is an advertisement of the shop or news of the district **(i.e., Fig. 3, input screen for displaying supplementary information such as additional information which may include an advertisement of the shop or news of the district).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the print ordering sheet of Wan '076 as taught by Ishida '868 since Ishida '868 suggested in Col. 2 lines 65-67 that such a modification would be to send order information efficiently.

1.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over '879 in view of '868 and further in view of Shiota (hereinafter " Shiota '596" 6,169,596)

With respect to **Claim 4**, Yoshino '879 teaches a print ordering sheet wherein the print order assigning section has a column for writing the number of the prints to be ordered **(I.e., 88 of Fig. 9, order processing section has a column for writing the number of prints to be ordered)**

The combination of Yoshino '879 and Ishida '868 do not explicitly teach a print ordering sheet wherein the print order assigning section for writing a print size of the Prints to be ordered.

However, the mentioned claimed limitations are well known in the art as evidenced by Shiota '596, In particular, Shiota '596 teaches the use of a print ordering

sheet wherein the print order assigning section for writing a print size of the prints to be ordered **(i.e., Col. 2 Lines 16-19, print ordering sheet comprising an assigning section for writing a print size for the prints to be ordered).**

In view of this, it would have been obvious to one having ordinary skill in the art at the time of invention was made to modify the print ordering sheet of Yoshino '879 and Ishida '868 as taught by Shiota '596 since Shiota '596 suggested in Col 1 Lines 44-50 that such a modification would be to provide a photo finishing system whereby order receiving processing which saves the time of a service provider can be carried out and a customer can enjoy convenience equivalent to the convenience in a network photo service by using a simple and reliable method, without having special equipment.

2.   Claims12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino '879 in view of Kobayashi et al. (hereinafter " Kobayashi '391" 5,907,391)

With respect to **Claim 12**, Yoshino '879 teaches a print order processing system **(i.e., Col. 1 Lines 49, print order system)**, comprising: a registration section for registering information about a group **(i.e.,81 of Fig. 9, new members of a group may be registered)** a control information generation section **(i.e.,5 of Fig. 1, Server)**for generating control information which control group information registered by the registration section **(i.e., Fig. 8, Server generates control information to a terminal about a group of registered members)** and member's common data shared by members of the group **(i.e., Col. 8 Lines 55-58, members of a group share common image data to order prints),** a producing section **(i.e., Fig. 4, Ordering table)** for producing an ordering sheet data for ordering prints by performing predetermined

process onto the members common data **(i.e., Fig.4 , Order table produces an**

ordering sheet for ordering prints by performing a predetermined process of

processing the image data inputted by the members), based on the control

information and the members common data shared by the members of the group **(i.e.,**

Fig. 4 and Col. 8 Lines 33-39, the order sheet is produced based on the shared

image data in the database of the server and the members of the group) and

wherein the producing section **(i.e., 6 of Fig. 1, server)** produces the ordering sheet

(i.e., Fig 4, Ordering Table) data which includes blank columns for inputting the

identification information of the members of the group **(i.e., Fig. 4,ordering table**

includes an unlimited number of columns where user nicknames for identification

may be entered), and on which the control information produced by the producing

section is recorded **(i.e., Fig. 4, control information is recorded as shown in Fig. 4**

by the server into the order table).

Yoshino '879 does not explicitly teach a print order processing system

comprising an outputting section for printing out an ordering sheet based on the

ordering sheet data.

However, the mentioned claimed limitations are well known in the art as

evidenced by Kobayashi '391, In particular, Kobayashi '391 teaches the use of a print

order processing system comprising an outputting section for printing out and ordering

sheet based on the ordering sheet data **(i.e., Col. 10 Lines 1-5, outputting section for**

printing an ordering sheet data based on ordering sheet data).

In view of this, it would have been obvious to one having ordinary skill in the art

at the time of invention was made to modify the print order processing system of

Yoshino '879 as taught by Kobayashi '391 since Kobayashi '391 suggested in Col. 7

Lines 55-58 that such a modification would provide an apparatus for accepting an order

for photographic processing, which can efficiently and correctly accept an order for

photographic processing from a customer.

With respect to **Claim 13**, Yoshino '879 teaches a printing order processing

system further comprising a member's common data inputting section for inputting the

member's common data shared by the members of the group **(i.e., Col. 8 lines 51-56**

and Fig. 4, a member inputs common image data to be shared by members of a

group).

With respect to **Claim 14**, Yoshino '879 teaches a printing order processing

system wherein the predetermined process to be performed onto the member's

common data indicates a printing process from the member's common **data (i.e., Fig. 4**

and Col. 2 Lines 4-6 , members common data and ordering table processes table

on the image data common among members and prints them out accordingly),

and the producing section produces the order receiving sheet data for ordering the

printing process of the members common data **(i.e., Col. 1 Lines 54-Col. 2 Lines 6,**

server produces an order sheet for ordering the printing process of the members

common image data).

With respect to **Claim 15**, Yoshino '879 teaches a printing order processing

system wherein the member's common data includes the image data **(i.e., Col. 8 lines**

51-56, image data inputted by a member is common among all members), and the

producing section produces the ordering sheet data, using thumbnail images of the

image data **(i.e., Col. 3 Lines 48-58, server produces an order table using**

thumbnail images of the image data).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dennis Dicker whose telephone number is (571) 270-

3140. The examiner can normally be reached on Monday -Friday 7:30 A.M. to 5:00

P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
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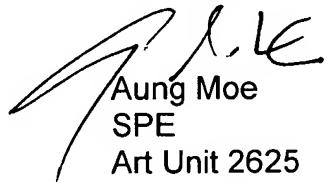
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